



Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Group Art Unit: 1714

Serial No.: 09/398,377

Examiner: Szekey, P.

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Mail Stop AF

Commissioner for Patents

Attention Petitions Branch

P.O. Box 1450

Alexandria, VA 22313-1450

12/15/2003 DTESSEH1 00000009 09398377

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PETITION

Sir,

This is a petition to the Commissioner

- (1) to direct the Examiner to withdraw the finality of the Office Action mailed October 10, 2003, on the ground that a clear issue for appeal has not been developed, and
- (2) insofar as the Commissioner deems it appropriate, to direct the Examiner to provide reasoned answers to the Applicants' arguments.

Background

On June 17, 2003, Applicants mailed a Petition to direct the Examiner as to the Correct Construction of the Claims. On October 7, 2003, the Commissioner dismissed

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop AF Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
On December 10, 2003

Typed name of person signing this certificate: T. H. P. Richardson
Signature

the Petition because there was no issue ripe for petition, there being at that time no final rejection, and because, although it was desirable that any appeal should be based on an agreed construction of the claims, that issue did not appear to be a petitionable matter. The decision also stated

Before making the next office action final, the Examiner should clearly point out how he is interpreting the claims and provide clear reasoning as to why he is interpreting the claims in that manner. Applicant's arguments regarding this matter should be thoroughly addressed.

Upon receipt of a final office action, if Petitioner feels that a clear issue for appeal has not been developed, then a petition to withdraw the finality can be filed.

Copies of the previously-filed Petition and the Commissioner's Decision are attached. Also attached is a copy of the Reply mailed June 17, 2003, to which reference will be made below.

The Examiner has now made a final rejection. Applicants believe that the finality of the rejection should be withdrawn, because a clear issue for appeal has not been developed. The issues that remain unclear are set out below.

1. The Construction of the Claims

For the reasons explained below, the correct construction of the claims is fundamental to clarification of the rejections under 35 USC 102 and 103. Under these circumstances, the Commissioner is asked to reconsider the earlier decision stating that the construction of the claims "does not appear to be a petitionable matter".

In the final Office Action, the Examiner makes the following statement with regard to the construction of claims.

Morawsky et al.... does contain the phrase "present in the amount sufficient to thicken the composition"... so that limitation is not new matter... Since Morawsky et al. define that amount as 0.1-12% by weight based on the oil, the phrase will be interpreted as such. Applicants do not agree with the Examiner about

Morawsky et al. limiting the useful concentration range of the thickener to the above range. It is their privilege. However this disagreement is completely inconsequential as far as the instant rejection is concerned.

Thus, the Examiner has not "thoroughly addressed" the reasons set out in the previously filed Petition, in particular in paragraphs A-D on pages 7-8 thereof, in support of Applicants' argument that the Examiner's construction of the claims is wrong. Rather, the Examiner has simply asserted that the disagreement as to the construction of the claims "is completely inconsequential so far as the instant rejection is concerned".

The Final Office Action then continues: --

Morawsky et al. prove that the 0.1-12% by weight based on the oil concentration range is synonymous to or within the claimed concentration range which thickens the oil. Therefore, said concentration range overlaps the 0.001-1% by weight based on the oil concentration range disclosed by Mueller et al 5,281,329, and thus applicants' claims are not novel or non-obvious over the disclosures of the cited references.

Applicants are not entirely confident that they have completely understood this passage. However, it appears that the Examiner is saying that because there is an overlap between

- (i) the broadest numerical range explicitly disclosed in Morawsky et al. (0.1-12%) for the amount of certain specifically defined carboxyl-containing side chain crystalline (SCC) polymer to be used to thicken oils, and
 - (ii) the broadest numerical range explicitly disclosed in Mueller et al. (0.001-1%) for the amount of certain specifically defined SCC polymers (which do **not** contain the carboxyl groups essential to Morawsky et al.) to be used in order to depress the pour point of certain oils (which necessarily means that the effect of the SCC polymer is to make the oil thinner, **not** to make the oil thicker),
- it necessarily follows that the rejected claims are not novel.

Thus, it appears that the Examiner is not only saying that the rejected claims are limited to amounts of the additive in the range 0.1-12%, but is also saying that the

stated requirement that the additive thickens the oil should be ignored. This is the only possible explanation for the Examiner's rejection of the claims under 35 USC 102 over Mueller et al, in which the additive is used in an amount which makes the oil thinner, not thicker. [At one time during prosecution, the Examiner appeared to think that use of an additive as a pour point depressant for an oil was synonymous with thickening the oil. In fact, the reverse is true; there can be no doubt that Mueller's additive, when used in accordance with Mueller's instructions, functions as a thinner in the temperature range between (i) the pour point of the oil and (ii) the pour point of the mixture of oil and additive--nor is there any reason to suppose that the same is not true at higher temperatures.]

Applicants believe, therefore, that the correct construction of claims, so far from being "completely inconsequential", is fundamental to the rejections, which must be withdrawn if the claims are correctly construed. Even if the Commissioner continues to think that the proper construction of claims is not a matter that can be dealt with by way of petition, Applicants suggest that the Commissioner should direct the Examiner to formulate his rejections in alternative forms, one form directed to the construction that the Examiner believes to be correct and the other form directed to the construction that Applicants believe to be correct. There will otherwise be a danger that, if the Examiner's construction is found to be wrong (no doubt after a lengthy appeal process), prosecution will have to resume, based on a new construction of claims.

2. The rejection of the claims under 35 USC 102

(a) A number of the claims have been rejected under 35 USC 102 "as being anticipated by Mueller et al 5,281,329, with Morawsky et al. 5,736 125 as a teaching reference". The claims were likewise rejected in the previous Office Action on this ground, and as out in detail on page 23, line 6-10, of the attached Reply, Applicants argued that such a rejection was improper because a rejection under 35 USC 102 must be based on a single reference. The Examiner has made no comment on the argument.

(b) As set out in detail on page 23, line 13, to page 26, line 10, Applicants argued that the rejection under 35 USC 102 should be withdrawn because (1) the claims require that the SCC polymer is present in an amount such that it thickens the oil, and (2) the claims are directed to cosmetic compositions. As noted above, it appears that the Examiner, because he has adopted an incorrect construction of the claims, thinks that the first of these differences is unimportant; in any event he has made no comment on Applicants' arguments beyond that set out above. As to the fact that the claims are directed to cosmetic compositions, the Final Office Action states: --

The Examiner iterates and reiterates his previous statements that Mueller et al encompasses such cosmetic compositions as mineral oil and vaseline...

The Examiner has made no comment on the arguments set out on page 24, lines 9-21 and page 25, line 17-page 26, line 10, of the previous Reply, for example the fact that Mueller does not disclose mineral oil or vaseline or any composition that is stated to be, or is inherently, a cosmetic composition.

3. The rejection of the claims under 35 USC 103

(a) A number of the claims have been rejected under 35 USC 103 over Mueller et al 5,281,329 in view of Morawsky et al. 5,736,125. The claims were likewise rejected in the previous Office Action on this ground, and as out in detail on page 26, line 26-page 27, line 13, of the attached Reply, Applicants argued that such a rejection was improper because there was no reason to read these references together. The Final Rejection contains no comment on this argument.

(b) Applicants also argued, on page 27, line 15-page 30, line 7, of the attached Reply, that even if the references could properly be combined, they did not disclose or suggest the claimed invention. For example, Applicants noted that

(i) the SCC polymers used by Mueller and Morawsky are different, and there is nothing to suggest that the SCC polymers used by Mueller are interchangeable with the SCC polymers used by Morawsky;

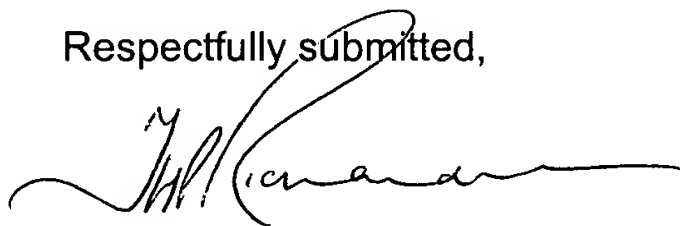
(ii) Mueller's objective is to lower the pour point of an oil, which necessarily means that the oil is made thinner, whereas Morawsky's objective is to thicken an oil;

(iii) Mueller discloses a preferred range of 0.005 to 0.2% for the concentration of additive, and in fact uses, in the specific Examples, 0.04 to 0.1%; and Morawsky discloses a preferred range of 0.5 to 10%, and in fact uses, in the specific Examples 5%., so that there is no overlap between the concentration ranges in which Mueller and Morawsky achieved practical results.

4. The rejection of claim 6 under 35 USC 103

On page 22, lines 26-31 of the attached Reply, it was noted that claims 6 and 7 had been rejected under 35 USC 102 and that claim 6 (but not claim 7) had been rejected under 35 USC 103; that those claims require the presence of hydroxyl groups in the SCC polymer additive; that there is nothing in Mueller to suggest the use of hydroxyl-containing SCC polymers; and that the office action says nothing about this difference. In the outstanding Final Rejection, claims 6 and 7 are no longer rejected under 35 USC 102, but claim 6 remains rejected under 35 USC 103, without any reasons given for the rejection.

Respectfully submitted,

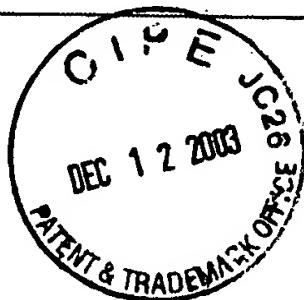


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Paper Number: 22

In re application of
Bitler et al.

Serial No. 09/810,920

Filed: March 16, 2001

For: POLYMERIC THICKENERS FOR OIL-CONTAINING COMPOSITIONS

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO DIRECT THE EXAMINER AS TO THE CORRECT CONSTRUCTION OF CERTAIN CLAIMS.

On March 31, 2003, a non-final office action was mailed to Applicants. The office action contained numerous rejections and objections to the specification based on new matter and claim interpretation. Petitioner argues that the instant specification provides support for all of the subject matter presented by Applicants and that the examiner is interpreting the instant claims too narrowly.

On June 23, 2003 the instant petition under 37 CFR 1.181 was filed to formally request that the examiner be directed to construct the instant claims in a correct manner.

DECISION

It is noted that the instant petition was submitted by Petitioner on June 23, 2003 which falls more than two months after the date of the office action thereby making the instant petition untimely under Rule 181.

In addition, it would appear on its face that there is no issue that is ripe for a petition at this time. It is noted that the outstanding office action is a non-final office action and therefore, the rejections and objections are not yet final. Petitioner states that "The examiner is currently examining these claims on the basis of a construction of the claims which Applicant believes to be wrong. The claims in question have been rejected, and it seems likely that their patentability will be the subject of an appeal. Applicant believes that it is important that further examination, and any appeal, should be based on an agreed construction of the claims." While this would be desirable, this does not appear to be a petitionable matter. It would seem that the issue of claim interpretation and the subsequent rejections/objections presented that are based upon this interpretation, should best be handled by the Board of Patent Appeals and Interferences.

COPY filed with Petition mailed 12/10/03

Accordingly, because the instant petition is untimely and because there does not appear to be a petitionable issue present, the instant petition is **DISMISSED**.

The examiner however, should take note of Section MPEP Section 706.07 of the MPEP which states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

Before making the next office action final, the examiner should clearly point out how he is interpreting the claims and provide clear reasoning as to why he is interpreting the claims in that manner. Applicant's arguments regarding this matter should be thoroughly addressed.

Upon receipt of a final office action, if Petitioner feels that a clear issue for appeal has not been developed, then a petition to withdraw the finality can be filed.

It is also pointed out that applicant's time for response continues to run from March 31, 2003. Extensions of time may be obtained to file any amendments.



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Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Group Art Unit: 1714

Serial No.: 09/398,377

Examiner: Szekely, P.

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Assistant Commissioner for Patents
Washington, DC 20231

Attention Petitions Branch

PETITION

Sir,

This Petition is being filed contemporaneously with a very similar petition on the closely related CIP application Serial No. 09/810, 920. It is believed that the Commissioner will find it convenient to consider both petitions at the same time.

This is a petition asking the Commissioner to direct the Examiner as to the correct construction of certain claims. The Examiner is currently examining these claims on the basis of a construction of the claims which Applicant believes to be wrong. The claims in question have been rejected, and it seems likely that their patentability will be the subject of an appeal. Applicant believes that it is important that further examination, and any appeal, should be based on an agreed construction of the claims.

The Claims

**Originally mailed June 17, 2003. This Copy filed with Petition
mailed December 10, 2003**

The invention relates to the use of certain side chain crystalline (SCC) polymers as thickening agents for oil-containing compositions. The claims in question are independent claims 40 and 45, which are set out below (with emphasis added). These claims are directed to compositions containing an oil and the thickening agent "in amount such that it thickens the oil". The Examiner is examining these claims on the basis that this phrase means (and that the claims are therefore limited to) compositions containing 0.1 to 12% by weight of the SCC polymer.

The application includes claims which are dependent on independent claims 40 and 45 and which have also been rejected. The application also includes other independent claims, and claims dependent thereon, which have been allowed and as to which there is no dispute.

40. *A thickened oil cosmetic composition which comprises*
- (1) an oil, and*
 - (2) dispersed in the oil, a polymer which*
 - (a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;*
 - (b) is soluble in the oil at temperatures above T_p ,*
 - (c) has been dispersed in the oil by a process which comprises*
 - (i) dissolving the polymer in the oil at a temperature above T_p , and*
 - (ii) cooling the solution to crystallize the polymer in the oil,*
 - (d) is a side chain crystalline (SCC) homopolymer which is substantially free of functional groups, and*
 - (e) is present in amount such that it thickens the oil;*
- the composition being at a temperature*
- (i) which is below T_p , and*
 - (ii) at which the composition, in the absence of the polymer, is liquid.*

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45. *A thickened oil cosmetic composition comprising*
- (1) an oil, and*
 - (2) dispersed in the oil, a polymer which*
 - (a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;*
 - (b) is soluble in the oil at temperatures above T_p ,*
 - (c) has been dispersed in the oil by a process which comprises*
 - (i) dissolving the polymer in the oil at a temperature above T_p , and*
 - (ii) cooling the solution to crystallize the polymer in the oil,*
 - (d) is a side chain crystalline (SCC) polymer which is substantially free of functional groups, and which consists of*
 - (i) 50 to 100% by weight of units derived from at least one *n*-alkyl acrylate or methacrylate in which the *n*-alkyl group contains 12 to 50 carbon atoms, and*
 - (ii) 0 to 50% by weight of units derived from at least one alkyl acrylate or methacrylate in which the alkyl group is not an *n*-alkyl group containing 12 to 50 carbon atoms, and*
 - (e) is present in amount such that it thickens the oil;*
- the composition being at a temperature*
- (i) which is below T_p , and*
 - (ii) at which the composition, in the absence of the polymer, is liquid.*

The Issue

Originally mailed June 17, 2003. This Copy filed with Petition mailed December 10, 2003

The issue is the meaning of the phrase "is present in amount such that it thickens the oil".

The Relevant Facts

1. The Disclosure of the Specification as filed.

The specification as filed does not state explicitly that the thickening agent "is present in amount such that it thickens the oil". It does, however, contain numerous statements and specific Examples which make it clear that the purpose and result of adding the crystalline polymer thickening agent is to thicken the oil. The following passages are quoted by way of example.

Polymeric Thickeners for Oil-Containing Compositions (title)

It is known to use polymers to thicken oil-containing compositions.

Reference may be made for example to U.S. Patent No. 5, 318,995 (Mondet et al.) and U.S. Patent No. 5, 736,125 (Morawsky et al.) the disclosure of each of which is incorporated herein by reference for all purposes. (Page 1, lines 10-13)

I have discovered, in accordance with the present invention, that oil-containing compositions can be thickened with polymers which contain long chain alkyl groups in side chains but which contain no, or relatively few, acid groups as specified in U.S. Patent No. 5,736,125 or acid salt groups as specified in U.S. Patent No. 5,318 995. Furthermore I have been able to obtain improved results through the use of such polymers. The polymers which are useful in the present invention are crystalline polymers, preferably side chain crystalline (SCC) polymers which...

the use of such polymers as thickening agents (page 3, lines 18-19),

the polymers used as thickeners in the present invention (page 5, line 15),

the thickening polymer (page 8, lines 23 and 30),

the polymeric thickener (page 5, line 13, page 9, lines 12, 18 and 25),

The amount of the polymeric thickener preferably used varies with the application. It is usually unnecessary to use more than 10% of the total

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composition, and smaller amounts such as 3 to 7%, for example about 5%, are often effective. (Page 9, lines 12-14)
a thickened oil composition (Claim 1, line 1).

2. After the claims had been rejected under 35 U.S.C. 102 and 103 over U.S. Patent No. 5,281,329 ("Mueller"), Applicant limited the claims to require that the thickening agent "is present in amount such that it thickens the oil", and argued that this limitation distinguished the claims from the Mueller reference.

3. The Examiner rejected the amended claims under 35 U.S.C. 112 for lack of written description on the ground that the added limitation involved new subject matter, and for lack of enablement.

4. In the Reply mailed July 31, 2002, and the Supplemental Reply mailed Oct. 17, 2002, Applicant traversed the rejection under 35 U.S.C. 112, arguing that no new subject matter was involved and that the claims were enabled, referring to the passages in the specification quoted above, and noting that the specification provides specific examples of thickened oils.

5. The Office Action mailed November 25, 2002, withdrew the rejection under 35 U.S.C. 112, and stated:

The Examiner acknowledges that Morawsky... incorporated by reference, does contain the phrase "present in the amount sufficient to thicken the composition" in column 3, lines 19-24, so that limitation is not new matter. Since (Morawsky) defines that amount as 0.1-12% by weight, the phrase will be interpreted as such.

6. The disclosure of Morawsky.

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Morawsky, which is also summarized on page 1, lines 15-24, of the specification as filed, discloses that certain specifically defined carboxyl-containing SCC polymers can be used to thicken oils. The following passages are quoted from Morawsky.

In the compositions, the amount of thickening copolymer, as defined above, is present in an amount sufficient to thicken the composition to the desired thickness. In general it is present in an amount of from about 0.1% to about 12%, particularly from about 0.5 to about 10% by weight of the oil.... The composition may be thickened to the desired viscosity which is dependent on the functional properties of composition. (Column 3, lines 19-33).

1. *A composition comprising an oil and a polymeric thickener consisting essentially of at least one copolymer which has a hydrophobic functionality sufficient to provide at least partial solubility in oil and a hydrophobic functionality present in an amount effective to provide thickening of the oil, said hydrophobic functionality being... (Claim 1).*

6. *The composition of Claim 1, wherein the copolymer is present in an amount ranging from about 0.1 to about 12% by weight of the oil. (Claim 6).*

7. In the Reply mailed January 27, 2003, Applicant argued, referring to the passages quoted in paragraph 6 above, that neither the claims nor Morawsky should be interpreted to have the limited meaning adopted by the Examiner; and asked the Examiner to state on the record that further examination would be carried out on the basis that the phrase mean simply what it says and is not limited to amounts in the range 0.1 to 12 %.

8. The Office Action mailed March 31, 2003, does not state whether the continued rejection of the claims was based on the Examiner's limited construction.

9. In a telephone interview with the undersigned on June 12, 2003, the Examiner made statements which, insofar as they could be understood by the undersigned,

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indicated that the Examiner was continuing examination on the basis of the limited construction of the claims.

10. In the Reply mailed contemporaneously with this Petition, Applicant asked the Examiner once again to consider the proper construction of the claims, and either

- (i) to state on the record his agreement that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%, or
- (ii) to send this Petition to the Petitions Branch so that the issue could be resolved.

11. The Reply mailed contemporaneously with this Petition also requests amendments which result in the following claims 42 and 50 which are dependent on claims 40 and 45 respectively, and which specify that the thickening agent is present in amount 0.1 to 12% by weight.

42. A composition according to Claim 40 wherein the SCC polymer is present in amount 0.1 to 12% by weight.

50. A composition according to Claim 45 wherein the SCC polymer is present in amount 0.1 to 12% by weight.

The specification as filed does not state explicitly that the thickening agent can be present in amount 0.1 to 12%. The basis for these claims is in above-quoted passages of Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference. Applicant's purpose in adding these claims is to provide further evidence, through the doctrine of claim differentiation, that claims 40 and 45 cover amounts of the SCC polymer outside the range of 0.1 to 12%.

Argument

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For the reasons set out below, Applicant believes that the claims 40 and 45 should not be examined on the basis of the limited construction adopted by the Examiner, but rather on the basis that the claims cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%.

A. The passages quoted in paragraph 1 above from the specification as filed make it clear that Applicant's invention is directed broadly to the use of the defined SCC polymers as thickening agents for oil-containing compositions, and is not limited to any specific numerical range of concentration. The disclosure of the specification itself is reinforced by the facts and arguments set out in

- (i) the Reply mailed July 31, 2002, and the Supplemental Reply mailed Oct. 17, 2002, and
- (ii) the Reply mailed January 27, 2002, on the CIP application Serial No. 09/810,190,

to which reference should be made.

B. The passages quoted in paragraph 6 above from Morawsky make it clear that Morawsky's invention is directed broadly to the use of the defined carboxyl-containing SCC polymers as thickening agents for oil-containing compositions, and is not limited to the use of 0.1 to 12% of the SCC polymer. The quoted passage from column 3, lines 19-33, states simply that the SCC polymer is used "in an amount sufficient to thicken the composition, and then goes on to state that "in general" (i.e. **not** invariably) the amount is from "about 0.1% to about 12%". Claim 1 similarly refers to "an amount effective to provide thickening of the oil", and the presence of Claim 6, specifying that the amount is 0.1 to 12% and not otherwise limiting Claim 1, puts it beyond doubt (having regard to the requirement of 35 U.S.C. 112, fourth paragraph, that a dependent claim must "specify a further limitation of the subject matter claimed) that the amount referred to in Claim 1 is not limited to the range of 0.1 to 12%.

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C. The presence of amended claims 42 and 50 makes it clear (again having regard to 35 U.S.C. 112, fourth paragraph) that claims 40 and 45 are not limited to the range of 0.1 to 12%.

D. MPEP 2111 requires that during Patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification".

Respectfully submitted,

T. H. P. Richardson,
Registration No.28,805,
Tel No. 650 854 630

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Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Group Art Unit: 1714

Serial No.: 09/398,377

Examiner: Szekely, P.

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Assistant Commissioner for Patents
Washington, DC 20231

REPLY

Sir,

INTRODUCTORY COMMENTS

This paper is a reply to the Office Action mailed March 31, 2003. Reexamination, reconsideration and allowance are respectfully requested in view of the Amendments and Remarks below. This reply has been prepared in accordance with the recently promulgated Revised Amendment Format.

Telephone Interview

A brief telephone interview took place on June 12, 2003, between the Examiner and the undersigned. Before the interview, the Examiner had been provided with a draft Reply. During the interview, the Examiner indicated that after amendment in the way proposed in the draft Reply and the filing of a terminal disclaimer, the previously rejected claims containing numerical ranges for the amount of the thickening agent

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would be allowable, but that the rejected claims specifying that the thickening agent is present in amount sufficient to thicken the composition would not be allowable. Applicant is not willing to limit the rejected claims to those containing numerical ranges.

The undersigned did not clearly understand other positions taken by the Examiner during the interview. Insofar as the undersigned was able to understand those positions, they appeared to be as follows.

- (1) The Examiner had earlier withdrawn his objection that it was new matter to state that the thickening agent was "present in amount sufficient to thicken the oil" because of the disclosure in Morawsky U.S. Patent No. 5,736,125, which was incorporated by reference in this application.
- (2) In view of (1) above, and because Morawsky discloses a range of 0.1 to 12% for the amount of the thickening agent, the Examiner construes the claims specifying that the thickening agent is present in amount sufficient to thicken the oil as being limited to the use of 0.1 to 12 % of the thickening agent.
- (3) Because Morawsky provided the basis for the requirement in some of the rejected claims that the thickening agent was present in amount sufficient to thicken the composition, it is clear that Morawsky is relevant to the rejection of those claims under 35 U.S.C. 102 and 103.

The amendments requested in the present Reply are the same as those requested in that draft Reply, with the following exceptions.

1. Claims 42 and 50 have not been canceled, but rather have been amended to specify that the amount of the SCC polymer is 0.1 to 12 % by weight (i.e. the preferred range of concentration disclosed in Morawsky U.S. Patent No. 5,736,125).
2. The requested amendment to the paragraph on page 9, lines 12-14, now refers to the amount of the polymeric thickener being sufficient to thicken the composition to the desired thickness, for example 0.1 to 12% by weight of the oil.

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This amendment reflects the disclosure on page 3, lines 19-22 of Morawsky U.S. Patent No. 5,736,125.

The arguments presented in the present Reply are similar to those presented in the draft Reply, but have been amended and amplified as to the issues which appear, from the telephone interview, to be at the root of the outstanding rejections.

Construction of Rejected Claims, and Conditional Petition

Applicants believe that it is important that the record should be clear as to the meaning of the claims requiring that the thickening agent is present "in amount such that it thickens the oil". If paragraph (2) above, summarizing statements made by the Examiner during the interview, is correct, there is a fundamental difference between the Examiner's and the Applicant's constructions of those claims. As explained previously, and again in the attached Petition, Applicant believes that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%. If the Examiner, after consideration of this Reply and the attached Petition, agrees that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%, he is asked to state that agreement on the record. If, however, the Examiner is not prepared to state such agreement on the record, he is asked to forward the attached Petition to the Petitions Branch.

Basis for the limitation that the thickening agent is present in amount such that it thickens the oil.

As noted in paragraph (2) above, in the telephone interview, the Examiner stated (insofar as the undersigned was able to understand what the Examiner said) that he had had earlier withdrawn his objection, that it was new matter to require that the thickening agent was "present in amount sufficient to thicken the oil", because of the

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disclosure in Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference in this application. Applicant believes that the proper construction of the claims in question is not dependent on the Examiner's rationale for withdrawing the objection. However, in case the Examiner thinks otherwise, the following points are noted.

1. Paragraphs 1 and 2, on pages 14-17 of the Reply mailed September 27, 2002, and paragraphs 1 and 2, on pages 1-3 of the Supplemental Reply mailed Oct. 27, 2002, set out in detail Applicant's reasons for believing that the requirement in question did not involve new subject matter or result in the claims which should be rejected for lack of enablement. One of the reasons was the incorporation by reference of Morawsky U.S. Patent No. 5, 736,125. The majority of the reasons focused on other relevant disclosure in the specification as filed.
2. Applicant believes that, even in the absence of the incorporation by reference of Morawsky, no new subject matter is involved in the requirement that the thickening agent should be present in amount sufficient to thicken the oil.

For the sake of completeness, the following additional points are noted.

3. Page 2 of the Office Action mailed November 25, 2002, after the Examiner had considered the arguments set out in the Reply mailed September 27, 2002, and the Supplemental Reply mailed Oct. 17, 2002, states:

The Examiner acknowledges that Morawsky..., incorporated by reference, does contain the phrase 'present in amount sufficient to thicken the composition' in column 3, lines 19-24, so that limitation is not new matter. Since the (Morawsky) Patent defines that amount 0.1-12% by weight, the phrase will be interpreted as such.

4. Pages 13-14 of the Reply mailed January 27, 2003, discusses the above-quoted passage in the Office Action mailed November 25, 2002, noting, with reasons, why the requirement should not be interpreted to mean that the amount is 0.1 to 12%, and asking the Examiner to state on the record that further

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examination of the claims in question had been carried out on the basis that the phrase "in an amount sufficient to thicken the composition" in Morawsky and the corresponding phrase "in amount such that it thickens the oil" in the claims mean simply what they say and are not limited to amounts in the range of 0.1 to 12%.

5. The outstanding Office Action makes no comment on the meaning of the claims in question.

AMENDMENTS

Amendments to the Specification

Please cancel the amendment previously requested in the Reply mailed September 27, 2002, to the paragraph beginning on page 9, line 12, and ending on page 9, line 14. Please replace that paragraph by the following paragraph.

The polymeric thickener should be used in an amount sufficient to thicken the composition to the desired thickness, for example 0.1 to 12% by weight of the oil. The amount preferably used varies with the application. It is usually unnecessary to use more than 10% of the total composition, e.g. 3-10%, and smaller amounts such 0.3 to 7%, for example of about 5%, are often effective.

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Amendments to the Claims

Please cancel claims 52 and 57, and amend claims 42, 48, 50, 55, 56 and 58 as shown below.

40. (Previously added) A thickened oil cosmetic composition which comprises
- (1) an oil, and
 - (2) dispersed in the oil, a polymer which
 - (a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;
 - (b) is soluble in the oil at temperatures above T_p ,
 - (c) has been dispersed in the oil by a process which comprises
 - (i) dissolving the polymer in the oil at a temperature above T_p , and
 - (ii) cooling the solution to crystallize the polymer in the oil,
 - (d) is a side chain crystalline (SCC) homopolymer which is substantially free of functional groups, and
 - (e) is present in amount such that it thickens the oil;
- the composition being at a temperature
- (i) which is below T_p , and
 - (ii) at which the composition, in the absence of the polymer, is liquid.

41. (Previously added) A composition according to Claim 40, wherein the SCC polymer consists essentially of units derived from an n-alkyl acrylate or methacrylate in which the n-alkyl group contains 12 to 50 carbon atoms.

42. (Currently amended) A composition according to Claim 40 wherein the SCC polymer is present in amount ~~at least 3~~ 0.1 to 12% by weight, based on the weight of the oil.

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43. (Previously added) A composition according to Claim 40 which contains 3 to 10% by weight of the SCC polymer.

44. (Previously added) A composition according to Claim 40 which is at a temperature of 20 to 25 °C and wherein T_p is more than 40 °C.

45. (Previously added) A thickened oil cosmetic composition comprising

- (1) an oil, and
- (2) dispersed in the oil, a polymer which
 - (a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;
 - (b) is soluble in the oil at temperatures above T_p ,
 - (c) has been dispersed in the oil by a process which comprises
 - (i) dissolving the polymer in the oil at a temperature above T_p , and
 - (ii) cooling the solution to crystallize the polymer in the oil,
 - (d) is a side chain crystalline (SCC) polymer which is substantially free of functional groups, and which consists of
 - (i) 50 to 100% by weight of units derived from at least one n-alkyl acrylate or methacrylate in which the n-alkyl group contains 12 to 50 carbon atoms, and
 - (ii) 0 to 50% by weight of units derived from at least one alkyl acrylate or methacrylate in which the alkyl group is not an n-alkyl group containing 12 to 50 carbon atoms, and
 - (e) is present in amount such that it thickens the oil;

the composition being at a temperature

- (i) which is below T_p , and
- (ii) at which the composition, in the absence of the polymer, is liquid.

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46. (Previously added) A composition according to Claim 45 which is substantially free of water.

47. (Previously added) A composition according to Claim 45 which is at a temperature of 20 to 25 °C and wherein T_p is above 40 °C.

48. (Currently amended) A composition according to Claim 45 which is ~~as~~ **at** a temperature of 20 to 25 °C and wherein T_p is 40-50 °C.

49. (Previously added) A composition according to Claim 45, wherein $T_p - T_o$ is less than 10°C.

50. (Currently amended) A composition according to Claim 45 wherein the SCC polymer is present in amount ~~at least 3~~ 0.1 to 12% by weight, based on the weight of the oil.

51. (Previously added) A composition according to Claim 45 which contains 3 to 7% by weight of the SCC polymer.

52. (Canceled)

53. (Currently amended) A composition according to Claim ~~55~~ 52 wherein the SCC polymer contains at least 80% by weight of repeating units containing a side chain comprising a linear polymethylene radical containing 10 to 50 carbon atoms.

54. (Currently amended) A composition according to Claim ~~55~~ 52 wherein the units derived from at least one n-alkyl acrylate or methacrylate in which the n-alkyl group containing 12 to 50 carbon atoms are units derived from at least one n-alkyl acrylate in which the n-alkyl group contains 16 to 50 carbon atoms

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55. (Currently amended) A thickened oil composition comprising

(1) an oil, and

(2) dispersed in the oil, ~~A composition according to Claim 52~~
which contains 3 to 10% by weight of the SCC polymer ~~a polymer~~
which

(a) has a crystalline melting point, T_p , and an onset of melting
temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;

(b) is soluble in the oil at temperatures above T_p ,

(c) has been dispersed in the oil by a process which comprises

(i) dissolving the polymer in the oil at a temperature above T_p ,
and

(ii) cooling the solution to crystallize the polymer in the oil,
and

(d) is a side chain crystalline (SCC) polymer which is

substantially free of functional groups, and which consists of

(i) 50 to 100% by weight of units derived from at least
one n-alkyl acrylate or methacrylate in which the n-alkyl
group contains 12 to 50 carbon atoms, and

(ii) 0 to 50% by weight of units derived from at least one
alkyl acrylate or methacrylate in which the alkyl group is not
an n-alkyl group containing 12 to 50 carbon atoms;

the composition being at a temperature below T_p .

56. (Currently amended) A composition according to Claim ~~55~~ 52 which is at a temperature of 20 to 25 °C and wherein T_p is more than 40 °C.

57. (Canceled)

58. (Currently amended) ~~A composition according to Claim 57 which contains~~ A
thickened oil composition which comprises

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- (1) an oil, and
- (2) dispersed in the oil, 3 to 10% by weight of the SCC polymer a side chain crystalline (SCC) homopolymer which
- (a) has a crystalline melting point, T_p , of 20 to 80 °C, and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than 10 °C;
- (b) is soluble in the oil at temperatures above T_p ,
- (c) has been dispersed in the oil by a process which comprises
- (i) dissolving the polymer in the oil at a temperature above T_p , and
- (ii) cooling the solution to crystallize the polymer in the oil,
- (d) contains at least 80% by weight of repeating units containing a side chain comprising a linear polymethylene radical containing 10 to 50 carbon atoms or a linear substantially perfluorinated polymethylene radical containing 6 to 50 carbon atoms, and
- (e) is substantially free of functional groups;
- the composition being at a temperature below T_p .

59. (Previously added) A thickened oil composition comprising

- (1) an oil selected from the group consisting of hydrogenated polyisobutylene; triglycerides; purcellin oil; isopropyl myristate; butyl myristate; cetyl myristate; isopropyl palmitate; butyl palmitate; ethyl-2-hexyl palmitate; isopropyl stearate; butyl stearate; octyl hexadecyl stearate; isocetyl stearate; decyl oleate; hexyl laurate; propylene glycol dicaprylate, diisopropyl adipate; animal oils; silicone oils; oleyl alcohol; linoleyl alcohol; linolenyl alcohol; isostearyl alcohol; octyl dodecanol; esters derived from lanolic acid; and acetyl glycerides.; and
- (2) dispersed in the oil, a polymer which
- (a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;
- (b) is soluble in the oil at temperatures above T_p ,

- (c) has been dispersed in the oil by a process which comprises (i) dissolving the polymer in the oil at a temperature above T_p , and (ii) cooling the solution to crystallize the polymer in the oil, and
- (d) is a side chain crystalline (SCC) polymer which is substantially free of functional groups, and which consists of
 - (i) 50 to 100% by weight of units derived from at least one n-alkyl acrylate or methacrylate in which the n-alkyl group contains 12 to 50 carbon atoms, and
 - (ii) 0 to 50% by weight of units derived from at least one alkyl acrylate or methacrylate in which the alkyl group is not an n-alkyl group containing 12 to 50 carbon atoms;

the composition being at a temperature below T_p .

60. (Previously added) A composition according to Claim 59, wherein T_p is above 40 °C.

61. (Previously added) A composition according to Claim 59, wherein T_p is 40-50 °C.

62. (Previously added) A composition according to Claim 59, wherein $T_p - T_o$ is less than 10°C.

63. (Previously added) A composition according to Claim 59, wherein the SCC polymer comprises a homopolymer of the n-alkyl acrylate in which the n-alkyl group contains 18 carbon atoms.

64. (Previously added)) A composition according to Claim 59, wherein the SCC polymer a homopolymer of the n-alkyl acrylate in which the n-alkyl group contains 22 carbon atoms.

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65. (Previously added) A composition according to Claim 59 wherein the oil is a vegetable oil.

66. (Previously added) A composition according to Claim 59 wherein the oil is selected from the group consisting of sunflower seed oil, sesame seed oil, rape seed oil, sweet almond oil, calphyllum oil, palm oil, avocado oil, jojoba oil, olive oil, castor oil, and grain germ oils.

67. (Previously added) A composition according to Claim 59 wherein the oil is selected from perhydrosqualene, dimethyl polysiloxane, phenyl dimethicones, isopropyl lanolate, isocetyl lanolate, octanoates of glycol, octanoates of glycerol, decanoates of glycol, decanoates of glycerol, and cetyl ricinoleate.

68. (Previously added) A thickened oil composition which is a water-in-oil emulsion and which comprises

- (1) an oil, and
- (2) dispersed in the oil, a polymer which
 - (a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;
 - (b) is soluble in the oil at temperatures above T_p ,
 - (c) has been dispersed in the oil by a process which comprises
 - (i) dissolving the polymer in the oil at a temperature above T_p , and
 - (ii) cooling the solution to crystallize the polymer in the oil,and
 - (d) is a side chain crystalline (SCC) polymer which is substantially free of functional groups;

the composition being at a temperature below T_p .

69. (Previously added) A thickened oil composition which is a water-in-oil emulsion and which comprises

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- (1) an oil, and
- (2) dispersed in the oil, a side chain crystalline (SCC) polymer which
 - (a) has a crystalline melting point, T_p , of 20 to 80 °C, and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than 10 °C;
 - (b) is soluble in the oil at temperatures above T_p ,
 - (c) has been dispersed in the oil by a process which comprises
 - (i) dissolving the polymer in the oil at a temperature above T_p , and
 - (ii) cooling the solution to crystallize the polymer in the oil,
 - (d) contains at least 80% by weight of repeating units containing a side chain comprising a linear polymethylene radical or a linear substantially perfluorinated polymethylene radical containing 6 to 50 carbon atoms, and
 - (e) is substantially free of functional groups;

the composition being at a temperature below T_p .

70. (Previously added) A composition according to Claim 69, wherein T_p is 40-50 °C.

71. (Previously added) A composition according to Claim 69, wherein the SCC polymer consists essentially of units derived from at least one n-alkyl acrylate or methacrylate in which the n-alkyl group contains 12 to 50 carbon atoms.

72. (Previously added) A composition according to Claim 69 which contains 3 to 10% by weight of the SCC polymer.

73. (Previously added) A composition according to Claim 69 which contains 3 to 7% by weight of the SCC polymer.

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REMARKS

After making the amendments requested above, the claims in this application are claims 40-51, 53-56 and 58-73.

AMENDMENTS

In the Specification

Page 9 has been amended so as to remove the reference therein to "at least 3%" and to include a reference to "0.1 to 12%". Basis for the amendment to page 9 will be found in the corresponding paragraph of the original specification and column 3, lines 19-22, of Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference.

In the Claims

Claims 42 and 50 have been amended to require that the amount of the SCC polymer is 0.1 to 12%, rather than at least 3%, and Claim 52 and 57 (which required at least 3% of the SCC polymer) have been canceled. As a result, none of the amended Claims specifies that the amount of the SCC polymer is at least 3%. Claims 55 and 58, dependent on canceled claims 52 and 57 respectively and requiring that the amount of the SCC polymer is 3-10%, have been rewritten in independent form. Claims 53-56, formerly dependent on canceled Claim 52, have been amended to make them dependent on claim 55. Claim 48 has been amended to correct a typographical error.

Basis for amended claims 42 and 50 will be found on page 3, line 22, and Claim 6 of Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference. The presence of claims 42 and 50 makes it clear (through the doctrine of claim

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differentiation) that claims 40 and 45 include any amount of the SCC polymer that causes thickening of the oil.

THE OBJECTIONS AND REJECTIONS

The Objection under 35 U.S.C. 132.

The objection under 35 U.S.C. 132 has been rendered moot by the amendments to the specification.

The Rejections under 35 U.S.C. 112

The rejections under 35 U.S.C. 112 have been rendered moot by the amendments to the claims.

The Rejections under 35 U.S.C. 102 and 35 U.S.C. 103

Applicants respectfully traverse

- (1) the rejection of claims 40, 41 and 44-49 under 35 U.S.C. 102 as anticipated by Mueller (U.S. Patent No. 5,281,329) with Morawsky (U.S. Patent No. 5,736,125) as a teaching reference, and
 - (2) the rejection of claims 40, 41 and 44-49 under 35 U.S.C. 103 as unpatentable over Mueller in view of Morawsky,
- insofar as those rejections can be understood, for the following reasons.

The Rejection under 35 U.S.C. 102

It is well-settled law that a rejection under 35 U.S.C. 102 must be based upon a single reference disclosing every feature of the rejected Claim. Applicant does not

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understand what is meant by the words "with Morawsky... as a teaching reference", but believes that Morawsky cannot be relevant to a rejection under 35 U.S.C. 102 over Mueller.

Mueller is concerned with improving the flow characteristics of petroleum oils and petroleum oil products containing paraffins which influence the flow characteristics of the oils at lower temperatures. The paraffins dissolve in the oil at higher temperatures, but crystallize out on cooling, and in this way, "the ability of the oils to flow is lowered or entirely prevented" (column 1, lines 14-19). Thus, as the temperature falls, crystallization of the paraffins begins at the "wax appearance point" or "cloud point" (column 2, lines 5-14), and as the temperature continues to fall, the viscosity of the oil rises until, at a temperature called the pour point, the oil will no longer flow. Mueller refers to the known polymeric flow improvers, for example the so-called 'pour point depressants' (column 1, lines 20-21), including long chain alkyl (meth)acrylates (i.e. SCC polymers). Mueller's invention is to provide an "outstanding flow improving effect" (column 4, line 35) by dissolving into the oil an additive which is a mixture of (i) a first relatively high-melting polyalkyl acrylate or polyalkyl methacrylate (onset of crystallization greater than 15 °C) and (ii) a second relatively low-melting polyalkyl acrylate or polyalkyl methacrylate (onset of crystallization equal to or less than 15 °C and at least 5 °C less than the onset of crystallization of the first SCC polymer). The polyalkyl acrylates and methacrylates disclosed by Morawsky are SCC polymers that do not contain carboxyl (or other functional) groups. The quantity of the additive is very small. A range of 1-10,000 ppm (0.001-1%) is given, with a preferred range of 0.005-0.2%. In Mueller's Examples, the amounts used are 4-1,000 ppm (0.004-0.1%).

For the reasons set out in detail in the previous response, there can be no doubt that Mueller's additive (i.e. the defined mixture of SCC polymers), when used in accordance with Mueller's instructions, functions as a thinner in the temperature range between (i) the pour point of the oil and (ii) the pour point of the mixture of oil and

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additive. Nor is there any reason to suppose that the same is not true at higher temperatures.

Column 3, line 60, to column 4, line 4, of Mueller states that the petroleum oils and petroleum oil fractions that can be improved by the invention are predominantly crude oils, vacuum gas oils and residual oils. The compositions disclosed in Mueller's Examples are all based on crude oils. There is no explicit reference in Mueller to cosmetic compositions. Nor is there any disclosure in Mueller of any composition that is inherently a cosmetic composition. Nor is there any suggestion in Mueller that his compositions can be cosmetic compositions. Only a very small proportion of oil-containing compositions are "cosmetic compositions" as defined by the Food, Drug and Cosmetic Act, since the great majority of oil-containing compositions are not intended to be "rubbed, poured, sprinkled, or sprayed on, introduced into, or otherwise applied to the human body... for cleansing, beautifying, promoting attractiveness, or altering the appearance". Certainly none of the specific compositions disclosed in Mueller are cosmetic compositions.

Thus, the most important differences between Mueller and the rejected claims 40, 41, and 43-49 can be summarized as follows.

1. In the rejected claims, the SCC polymer must be present **in an amount such that it thickens the oil**.
2. The rejected claims are directed to **cosmetic** compositions.

Difference 1

Mueller does not use his additive, the mixture of specified SCC polymers, in amounts which thicken the oil. On the contrary, Mueller's additive is used as a pour point depressant. The additive-containing composition has a lower viscosity, at temperatures between (i) the pour point of the oil and (ii) the pour point of the mixture of oil and additive, than the composition not containing the additive. In other words,

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Mueller's additive acts as a thinner, not a thickener. There is no reason to suppose, reading Mueller, that there are any circumstances under which Mueller's additive will thicken the oil. When Mueller's compositions are at a temperature below the pour point of the mixture, they cannot be poured, i.e. are solid. They are solid because of the low temperature, not because they have been thickened by the mixture of SCC polymers. However, in order to eliminate any possibility that Mueller's compositions, when they are at a temperature below the pour point of the mixture, can be regarded as within the scope of independent claims 40 and 45 (and the claims dependent thereon), those claims further require that the composition is at a temperature at which the composition, in the absence of the SCC polymer, is liquid.

Difference 2

In the outstanding Office Action on the CIP application, Serial No. 09/810,920, but not in the present Office Action, the Examiner has stated

- (a) that the fact that the claims are directed to cosmetic compositions has no patentable significance, and
- (b) that "mineral oil and vaseline oil are cosmetic compositions and they are petroleum oil fractions, which are part of the invention of Mueller".

The following comments are made on those statements, in case the Examiner thinks that they are also relevant to the examination of this application.

It is well-settled law that every feature of a Claim, especially a feature added to a Claim during prosecution to distinguish from the prior art, is relevant to the construction of the Claim, and, therefore, its patentability. Applicant does not understand, therefore, why the Examiner thinks the limitation of the rejected claims to cosmetic compositions should be ignored.

The statement that "mineral oil and vaseline oil are cosmetic compositions and they are petroleum oil fractions, which are part of the invention of Mueller" could be read

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as implying that mineral oil and vaseline oil are disclosed in Mueller, which is not correct. Mueller does indeed disclose petroleum oil fractions, and mineral oil and vaseline oil are indeed petroleum oil fractions. But mineral oil and vaseline oil represent a very small proportion of all petroleum oil fractions, and are not disclosed by Mueller. The Examiner has not advanced any reason for supposing that one skilled in the art, reading Mueller, would consider the possibility that Mueller was referring to mineral oil and vaseline oil as possible petroleum oil fractions. But even supposing that to be the case, there is still no disclosure or suggestion in Miller of a cosmetic composition. It is true that some cosmetic compositions contain mineral oil and vaseline oil. But it is also true that many compositions containing mineral oil and vaseline oil are not cosmetic compositions.

The Rejection under 35 U.S.C. 103

The rejection under 35 U.S.C. 103 is based on Mueller in view of Morawsky. This is a new rejection, although Morawsky is already of record, being referred to in the specification itself and being one of the documents listed in the Information Disclosure Statement filed with the application.

It is well-settled law that a rejection cannot properly be based on a combination of references unless there is some reason to read the references together. As the MPEP puts it in 2143.01

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

As the CAFC put it in ACS Hospital Systems vs. Montefiore, 221 USPQ 929

*Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined **only** there is some suggestion or incentive to do so.*

The Examiner has not given any reason for combining the references. Nor is there in fact any such reason. On the contrary, there are positive reasons why the references

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would **not** be read together. Mueller is directed to **reducing** the thickness of certain oil-containing compositions. Morawsky has an opposite objective, namely **increasing** the thickness of certain oil-containing compositions. Morawsky requires the use of SCC polymers containing carboxyl groups. There is no disclosure of such SCC polymers in Mueller. Without knowledge of the present invention, therefore, there is no reason to read Mueller and Morawsky together.

Even if, which is denied, the references can properly be combined, the combination of them does not disclose the claimed invention. As noted above, Morawsky requires the use of SCCP additives containing carboxyl groups, and such additives are excluded from the claims (which require that the SCC polymer is substantially free of functional groups). Thus the combination of the references fails the requirement set out in MPEP 2143.01 that

the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Office Action, in support of the rejection under 35 U.S.C. 103, states

Morawsky shows "that the concentration range at which an SCCP thickens oil is from about 0.1% to about 12%. This overlaps the concentration range of 0.001 to 1% claimed by Mueller. This makes the argument about pour point depressants being viscosity depressants moot.

The first sentence of this statement is factually incorrect. Morawsky is not concerned with SCC polymers in general. Morawsky discloses only that **certain specifically defined carboxyl-containing** SCC copolymers (as defined, for example, in Claim 1 of Morawsky) can be used to thicken oils. Nor does Morawsky "show" that any SCC polymer, even the specifically defined carboxyl-containing SCC copolymers, thickens oils at all concentrations from about 0.1% to about 12%. Nor does Morawsky state that SCC polymers, even the specifically defined carboxyl-containing SCC copolymers, will thicken oils **only** at concentrations of 0.1 to 12%. Morawsky says that his carboxyl-containing copolymers should be used "**in an amount sufficient to thicken the composition to the desired thickness**" (col. 3, lines 19-21); and that the

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amount is "in general... from about 0.1% to about 12%, preferably about 0.5 to about 10%, by weight of the oil" (col. 3, lines 21-24).

Morawsky's specific Examples, which no doubt report the best method known to Morawsky of carrying out the invention, make it clear that Morawsky does not provide any teaching of useful compositions at the lower end of the range of 0.1 to 12%. Thus, the amounts used in Morawsky's specific Examples range from 2.5 to 5%. Morawsky's specific Examples also demonstrate the importance of

- (i) the presence of the carboxyl groups on the SCC polymer, and
- (ii) using a sufficient quantity of the SCC polymer.

Example 1 uses five different SCC copolymers, each in amount 5% based on the weight of the oil. Even at this concentration (50 times the low end of the 0.1 to 12% range), one of the carboxyl-containing copolymers (Sample 124-93, containing 4 % of acrylic acid) produced only a very small increase in viscosity. The other SCC copolymers in Example 1 contained 5-10% of acrylic or methacrylic acid, and produce substantially greater increases in viscosity. Sample 124-194, containing 7.5 % of methacrylic acid, was the most effective thickening agent. In Examples 2, 3 and 4, Sample 124-194 was used in amount about 2.5%, about 4% and about 3.3% respectively, based on the oil, to produce compositions whose viscosities were less than 1/10, a little more than 1/3, and a little more than 1/5, respectively, of the viscosity of the composition produced by the same SCC polymer at 5 % in Example 1.

[It should be noted that in an earlier Reply, Applicant stated that Morawsky uses, in his specific Examples, 1 to 2.5% of the SCC polymer. That was incorrect.]

The Examiner is correct stating that Mueller claims a concentration range of 0.001 to 1%, based on the weight of the oil, and is also correct, on a strictly arithmetical basis, that this range overlaps the range of 0.1 to 12% disclosed by Morawsky. However, this needs to be viewed in the context of the Mueller and Morawsky specifications as a whole. Thus, Mueller discloses a preferred range of 0.005 to 0.2%

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and in fact uses, in the specific Examples, 0.04 to 0.1%, and Morawsky discloses a preferred range of 0.5 to 10%, and in fact uses 2.5 to 5%

It appears that the Examiner is arguing that, because the broadest concentration ranges disclosed in Mueller and in Morawsky overlap, it is not important that

- (1) Mueller and Morawsky are concerned with different SCC polymers,
- (2) Mueller's objective is to reduce the thickness of oils, and Morawsky's objective is to increase the thickness of oils, and
- (3) there is no overlap in the preferred concentration ranges, and there is a large gap between the highest concentration used by Mueller and the lowest concentration used by Morawsky in their respective specific Examples.

Applicant, however, believes that these differences are extremely important, and that in view of them, the rejection under 35 U.S.C. 103 should be withdrawn. The following points in particular should be noted.

1. There is nothing in the references, or elsewhere in the prior art, to suggest that the mixture of SCC polymers used by Mueller is interchangeable with the carboxyl-containing SCC polymers used by Morawsky.
2. Mueller's objective is a reduction in the pour point of certain oils. As noted previously, a reduction in the pour point of an oil necessarily also means a reduction in the thickness of the oil. There is nothing in Mueller to suggest that his mixture of SCC polymers will, under any circumstances, produce the opposite result, namely an increase in the thickness of the oil.
3. Morawsky's objective is an increase in the thickness of the oil. There is nothing in Morawsky to suggest that his carboxyl-containing SCC polymers will, under any circumstances, produce the opposite result, namely a decrease in the thickness of the oil.

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4. Although there is, mathematically speaking, an overlap between the concentration ranges of 0.1-12% and 0.001-1%, these ranges cannot be removed from the context of the references in which they appear. The references, read as a whole, make it clear that in the quantities stated to be preferred, and in the quantities for which there is any experimental verification, the amounts used by Mueller (0.004-0.1%) are completely different from the amounts used by Morawsky (2.5-5%).

The Provisional Double Patenting Rejection

Applicants will address the issues raised by the provisional double patenting rejection when the claims of this application and Application Serial No. 09/398,377 are otherwise in condition for allowance.

CONCLUSION

It is believed that this application is now in condition for allowance, and such action at an early date is earnestly requested. If, however, there are any outstanding issues that could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

Respectfully submitted,

T. H. P. Richardson,
Registration No.28,805,
Tel No. 650 854 630

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Image

AE 1714

TRANSMITTAL FORM AND FEE TRANSMITTAL

Attorney Docket No.:	12969	First Named Inventor (a):	Bitler
Application No.:	09/398,377	Filing Date:	09/17/99
Examiner:	Szekely P.	Group Art Unit:	1714

This Transmittal Sheet is accompanied by

Petition, check for \$130.00, and an Acknowledgement Postcard

Fee Calculations (Applicant is a small entity)

Applicable Fee					Fee Paid
(1) Filing fee					\$
740/370					
(2) Extra claim fees	No. in Specification or after Amendment	No. Included in Filing Fee or Previously Paid For	No. Extra (b)	Applicable Fee	Fee Paid
Total Claims	32	- 34 =	0	x 18/9	
Ind. Claims	6	- 7 =	0	x 80/40	
Multiple dependent claim(s) presented for first time (c)			No	280/140	
Subtotal (2) Extra claim fees					
(3) Additional or other fees					Fee Paid
Extension for Reply (1,2,3 months: \$110/55, 400/200, 920/460) month(s)					
Petition to Commissioner (\$130)					130.00
Information Disclosure Statement (\$180)					
Subtotal (3) Additional or other fees					
Total Fees Submitted (Sum of Subtotals (1), (2), and (3))					130.00

5 A check for \$130.00 is attached

This Sheet is transmitted in duplicate.

Authorization to Charge Deposit Account for Additional Fees

10 The Assistant Commissioner for Patents is hereby authorized to charge any additional fees required under 37 CFR §§ 1.16 and 1.17, and credit any overpayments to, the following deposit account.

Deposit Account No: 19-2090

Deposit Account Name: Sheldon & Mak

CERTIFICATE OF MAILING UNDER 37 CFR

1.8

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop AF Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

On December 10, 2003 Typed name of person signing this certificate: T. H. P. Richardson

Signature

T. H. P. Richardson

Respectfully Submitted,

T. H. P. Richardson

Name T. H. P. Richardson
Tel. No. 650-854-6304 Fax No. 626-795-6321
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